THE MAGAZINE OF THE UNITED STATES PATENT & TRADEMARK OFFICE

USPTO TODAY

INSIDE:

May 2000
Special Edition - Trademarks

An Inside View:

Anne H. Chasser comments on her first six months in charge of the Trademark Operation

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USPTO TODAY

May 2000
Special Edition - Trademarks

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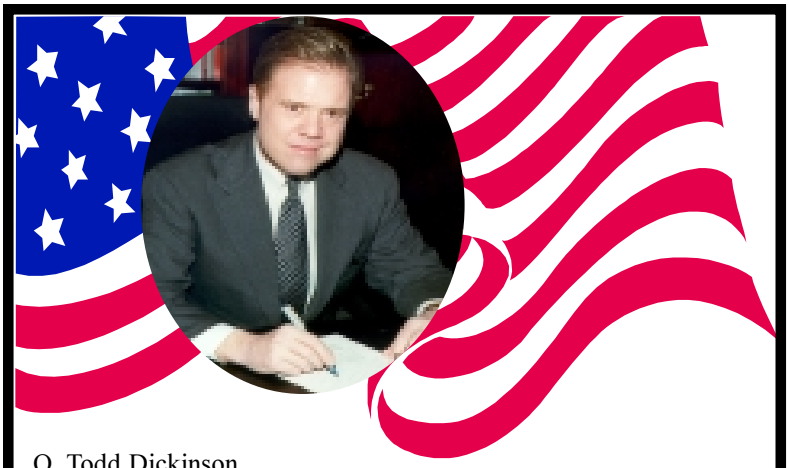


Q. Todd Dickinson
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

With the Under Secretary for IP

Welcome to the May edition of *USPTO Today*, which we are pleased to devote entirely to Trademarks.

As I've mentioned in previous columns, our workload at the USPTO is growing by leaps and bounds — and trademark filings are actually surpassing patents in this growth.

Last year, we received a record 295,200 trademark applications, an increase of 27 percent from the previous year, and registered more than 104,000 classes. That is one of the largest one-year increases ever. Nonetheless, this year trademark applications are already up 39 percent from the same period a year ago, with some of the largest increases occurring in the computer and computer-related service areas.

Under the very able leadership of our new commissioner for trademarks, Anne Chasser, we are managing this growth in a number of ways. First, we continue to augment the size of our examining workforce. Last year, we hired 136 examining attorneys, bringing the size of our trademark examining workforce to nearly 370. At the same time, we're implementing state-of-the-art technology to allow customers to secure our products and services over the Internet.

We are the first national intellectual property office in the world to offer an electronic filing system for trademarks. The system — known as TEAS (Trademark Electronic Application System) — allows our customers to submit applications over the Internet and use credit cards to pay filing fees – 24 hours a day, 7 days a week, 365 days a year — without ever leaving the comfort of their homes or offices.

Yahoo Magazine has cited TEAS as one of the most useful sites on the Internet. One user of TEAS actually emailed us to say that it was the "nicest interaction" she ever had with the federal government.

To complement TEAS, we also recently introduced the Trademark Electronic Business Center. This is a single place on the USPTO website that contains everything you need for the entire registration process. For example, you can search our trademark database for conflicting marks by using TESS, the Trademark Electronic Search System. You also can access trademark application and registration status, mark, ownership, and prosecution information using TARR, the Trademark Application and Registration Retrieval system.

Later this year, we also will implement the concept of "one stop electronic shopping" in our Trademark Examining Operation. Under this system, electronic applications will be routed directly to an e-commerce focused law office for all initial processing, examination, intent-to-use processing, and publication for opposition. These applications will receive prompt examination, often much faster than their paper counterparts. We are very excited about the ways this system will make our trademark operations even more user-friendly.

International developments have had a favorable impact on our trademark applications. For example, late last year we began to implement the Trademark Law Treaty, which harmonizes the procedures of national trademark offices worldwide and reduces the number of formal requirements needed for registration. In addition, we hope to begin soon implementing the Madrid Protocol, which will allow trademark owners in the United States to apply to register their marks in any of the 65 Madrid countries by filing a single application, in either English or French, at our offices.

Feature

Trademarks and You

by Eleanor Meltzer, Attorney-Advisor,
Office of Legislative and International Affairs

What are Trademarks?

"Intellectual property." It sounds so difficult. But actually, when you think about it, we all know about "intellectual property."

Take this easy quiz. You will discover that you know quite a bit about trademarks, one important form of "intellectual property." [*Answers appear at the bottom of this article, but you probably won't need to use them!*]

1. This is a picture of:

a. a Frisbee®

b. a flying saucer

c. a flying disc

2. This is a picture of:

a. aluminum foil

b. a Hershey's® Kiss

c. a party favor

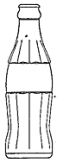
3. What does this identify?

a. a country

b. a car

c. a shoe

4. What product would you expect in this bottle?



a. pancake syrup

b. beer

c. soda

How Did you Do On the Quiz?

Easy, wasn't it? We may not all know what NaCl represents, but we do know that this young lady is "the salt of the earth."

You get the picture! Trademarks make complex ideas simple and present information to us in a language we all understand. Whether words, designs (shapes), slogans, colors, sounds, or scents, we are all very familiar with trademarks. Trademarks are: source identifiers, quality indicators, and business interests.

How do Trademarks Affect You?

Trademarks are how we buy products. Sometimes, the most important thing about a product is the fact that it has a logo on it! Talk to your kids or your neighbors' kids - - no matter what their age, they are all familiar with a trademark that is important to them – Barney®, Arthur®, Sesame Street®, Pokemon®, The Backstreet Boys®, Tommy Hilfiger®, Eddie Bauer® -- the list goes on.

Let's imagine you are sick. Growing up, you always were given a specific brand of cold medicine. As an adult, most of us are going to buy the same brand that we used as kids. When we're sick, we don't want to fool around buying some "no-name" medicine. Do we? Purchaser loyalty is the power and importance of a trademark. Long after the patent has expired, long after the copyright protection is gone, it is the trademark – the symbol of quality and source – that keeps consumers buying the same brand.

Now, let's say you are traveling in a foreign country. You like the food there, but you really could eat something that reminds you of home. One restaurant says "Authentic American Cooking." The other restaurant is a fast-food restaurant popular in the United States. For a lot of us, the brand that we grew up with is going to be the one to which we are loyal. And why travel thousands of miles to eat the same food we can get at home? Because, the trademark tells us we are going to get the same quality, from the same source that we are used to having. Trademarks let us know exactly what we are buying.

Why Employees of the U.S. Patent and Trademark Office Are So Important

Trademarks keep customers loyal. And because they can be renewed indefinitely (forever) at the United States Patent and Trademark Office, trademarks can be the most valuable assets a business owns.

Maybe your mother has a great idea and wants to invest her retirement money in her dream: a beauty salon. She is so excited about everything, and she has a great name: "HAIR TODAY." What a fabulous name! It suggests that her styling is totally modern, and also lets folks know that she specializes in hair. But how is your mom going to make sure she can protect her great name? Well, if we don't do our job at the U.S. Patent and Trademark Office, your mom might have a long and frustrating wait to finally get all of the legal protection to which a federal trademark registration will entitle her.

What happens if we don't let your mom know we've received her application? What if we lose a part of her file and tell her, "Too bad – you need to send us another check"? What if we keep misplacing your mom's application file? Does she have the resources to keep calling us, day after day, to find out where it is? And if your mom is calling us long distance and we keep passing her around without giving her an answer, can she afford that? And what if we write your mom long letters that don't really explain things in understandable terms?

It's true that many of our customers are trademark professionals. But a huge number are basically just like our moms - - they're normal people who understandably aren't familiar with how our office works. We need to make sure that every file is handled with the care we would devote to mom's file. Because every trademark application and registration is important to someone.

Quiz Answers:

1. a. Did you know that the trademark Frisbee® comes from the name of the Frisbie Pie Company, located in Bridgeport, Connecticut? In the 19th century, factory workers had fun tossing the pie tins to one another!

2. b. Did you know that chocolate candy (as we know it) wasn't available until around 1825?

That's when Conrad Van Houten, a Dutch chemist, invented a cocoa press that enabled confectioners to make chocolate candy by mixing cocoa butter with finely ground sugar.

3. c. This symbol is also referred to as the "Nike Swoosh"!

4. c. Safety tip: Never put other liquids (such as gasoline or cleaning fluids) into another type of container – even if you write the new contents on a label. Young children who can't read already know about trademarks. They will recognize the shape of the container and might mistakenly drink from the bottle because they think that it contains a soft drink!!

Participants in Eleanor Meltzer's workshops may have to duck every now and again, but they leave with a heightened awareness of the value of trademarks not only to trademark owners, but also to consumers.

The Trademark Electronic Application System (TEAS)

by Craig K. Morris, Manager, Trademark Business Process Reengineering

In the Beginning . . .

There once was a time when the words "cutting-edge" and "Trademark Operation" would have been an oxymoron, what with a 19th century paper-based system seemingly still tied to Thomas Jefferson, whose "shoe boxes" served as the model for storing records in the paper search library still available today. However, in the early 1980's, the Commissioner of Patents and Trademarks proposed a far-reaching goal for the United States Patent and Trademark Office to become a paperless office.

Early initiatives to move toward a paperless office did not succeed because they were limited to the then-available technology, which was not user-friendly. That is, from 1992 to 1995, the USPTO explored options for non-paper filing through two pilots, EASY (Electronic Application System) and TEDI (Trademark Electronic Data Interchange). EASY required submissions on floppy disks. According to participants, EASY, ironically, was too difficult to use. TEDI was based on a file transfer protocol that customers found only marginally better. As the Internet and the World Wide Web gained acceptance as a method of business communication, customers began asking for a trademark filing system that would fully use these technological advances. USPTO responded to these requests by developing TEAS—the Trademark Electronic Application System.

"We've Come a Long Way, Baby"

TEAS began as a pilot program on November 30, 1997, with approximately 50 customers. The law firm of Woodcock, Washburn, Kurtz, Mackiewicz & Norris, LLP, filed the first application very shortly after the electronic filing site opened. It was for a stylized design composed of triangular shapes, for "legal services." Following a successful 10-month pilot period, on October 1, 1998, TEAS opened worldwide at http://www.uspto.gov/teas/index.html.

Not only did the Trademark Operation step onto the information superhighway, it raced out in front. The USPTO is now one of the leaders in the government arena in the area of electronic commerce. Although not directly involved with TEAS, both Vice President Gore's National Performance Review and the Commerce Department played formative roles in the development of TEAS. Their push for the development of e-commerce, prescribed as a "high impact agency" goal, helped motivate the USPTO truly to meet the needs of its customers. It is also important to note that TEAS parallels the way in which many cutting-edge businesses now conduct *their* business, making the option of electronic filing particularly relevant.

Clearing the Hurdles

Through TEAS, the agency can bet-

ter address two critical problems: (1) the failure of all trademark owners to seek federal registration and (2) the demands to meet dramatically increasing workloads.

Some trademark owners have minimal financial resources and knowledge of intellectual property. Small businesses often cannot afford the professional legal help routinely used by large companies. Finding the registration process intimidating, these small businesses often forgo the benefits of federal registration. Also, in the past, there was no easy way to know that USPTO materials about the registration process existed, or how to obtain these materials. As a result, the USPTO's register reflects only a small percentage of trademarks now in use.

The USPTO must handle more applications both accurately and cost-effectively. Trademark application filing levels rose 32 percent since 1997 to just over 240,000 applications filed last year. In the first six months of this year, filings are up nearly 40 percent. Paper filings require the USPTO to transcribe very exact application data, like applicant names and listings of goods, from an unlimited variety of formats into a standard format for use in the USPTO's automated systems. This is a labor-intensive process with a high human error rate in data entry; volumes of paper lead to many mishandled and lost filings. The result is poor customer service. USPTO recognized that it could perhaps best overcome these two hurdles by offering customers the option of filing trademark applications electronically.

Access: Key to Success

Federal trademark registration is not mandatory. However, the USPTO's register of trademarks benefits businesses by listing trademarks currently in use, thereby providing greater certainty about the availability of trademarks. The register also benefits consumers by reducing the likelihood of their encountering confusingly similar trademarks in the marketplace. More trademark owners should apply for federal registration.

TEAS helps meet this goal by making a wealth of information available in one convenient site to anyone with Internet access. Today, *all* customers can quickly and simply reach a trademark application form on the USPTO home page, complete the form with extensive on-line help, and transmit the application directly on-line paying by credit card or deposit account. Or, by using a second option available through TEAS, customers can complete an application on-line, print it out, sign in the traditional "pen and ink" manner, and then mail it to the USPTO paying by check or deposit account (a credit card payment option for paper applications should be available in the near future). Even customers without Internet access can use computer systems at Patent and Trademark Depository Libraries around the country.

TEAS can even handle applications for marks consisting of a design element, and/or where based on actual use in commerce (requiring submission of a sample of how the mark is being used; for example, a tag or label for goods or an advertisement for services). For these images, customers simply attach a file to the application in the GIF or JPG file format. To "sign" a TEAS application, the customer simply types in any combination of alpha-numeric characters placed between two forward slash symbols (/). For example, /john smith/ or /js/ or /s123/ would all be acceptable signatures. This is totally left up to the signatory, and does *not* require any sort of approval by the USPTO.

Improved Efficiency and Quality

Besides providing critical access to the federal registration process, TEAS has accelerated the process and enabled the USPTO to capture data electronically. This has vastly improved the accuracy and efficiency of data processing. Trademark operation staff can complete initial processing and data capture for TEAS filings in 80 percent less time than paper applications. Data from TEAS applications are entered in trademark databases in 20-25 days, whereas data from paper-filed applications are not entered for 100-110 days. Staff can process TEAS filings more quickly because data are submitted electronically, whereas paper filings require key entry of data or capture by optical character recognition, methods that are labor intensive and susceptible to error. In an unacceptable number of paper applications, customers must request that the USPTO correct errors that are made during the initial capture of data. Data from TEAS filings is captured in structured formats, which further accelerates the process and ensures that the data is transferred without errors.

To TEAS or Not to TEAS, That is the Question

If you are interested in filing a trademark application, why should you consider using TEAS? Because TEAS addresses many specific problems inherent in a paper-only system, including:

- **Receiving forms**. You can easily access applications on the Internet at any time, rather than telephoning for mailed forms.
- **Help.** You can view help sections for each data field at the bottom of the web screen, as well as access a wide variety of information about USPTO procedures and practice, thereby eliminating telephone calls. Also, you can e-mail questions to a TEAS Help Desk, which shortens response times.
- **Irrelevant sections and duplication of effort.** You can create tailored forms by eliminating irrelevant data fields by answering a series of "Yes" and "No" questions in an initial form "Wizard." Also, you can save the on-line form as a template for later use, eliminating the repetition of information.
- **Failure to provide required information.** Once the application is completed, an automated validation function confirms that all mandatory information fields have been entered to receive a filing date; otherwise, you receive an error message. Although the other fields are optional for filing date purposes, customers should complete *all* fields for which all necessary information is available, to avoid later delays in prosecution. TEAS does not, however, in any way check the *validity* of information entered, nor does it perform any sort of search to see whether the mark is registrable. The assigned examining attorney performs these functions in the normal course of prosecution of the application. Nonetheless, the validation function improves the overall quality of applications and helps ensure that applications are not returned to customers for failing to meet application filing requirements.
- **Payment.** Under the paper filing system, the USPTO, to-date, only accepts fee payment in the form of a check or money order, or through a deposit account. For some customers, this is a financial hardship. TEAS permits credit card payments, which would allow for payment over time, if you so choose. This also assists foreign filers, because of the currency conversion. The USPTO accepts MasterCard, Visa, American Express, and Discover.
- **Acknowledgement of receipt of application.** With a mailed application, there is no way to immediately confirm receipt by the USPTO. You would not receive the assigned serial number for approximately four months. TEAS, however, provides within 24 hours a confirmation e-mail that includes the assigned serial number as well as a summary of the information entered in the application.

Other Benefits of TEAS

Through TEAS, you can also take advantage of the following:

- **Convenience of filing 24 hours a day, seven days a week.** TEAS is based on the Internet, so you can use TEAS almost 24 hours a day, 7 days a week, 365 days a year (there is a brief period, from 11 p.m. Saturday to 6 a.m. Sunday EST when credit card transactions cannot be processed). TEAS issues a filing date for the date in question up until midnight, EST. Being able to file quickly and having up to seven extra hours before a filing date passes may be crucial. Using the paper system, filings dates may be lost if applications are not filed at the USPTO by 5 p.m. EST, or timely mailed via U.S. Postal Service Express Mail. If an application is filed after midnight, the filing date is the next regular business day. However, an e-TEAS filing *could* be made on a day that the USPTO is closed (e.g., Saturday), and the USPTO will accord a filing date for that day (rather than the next regular business day).
- **Portability of form.** Many attorneys are concerned about obtaining the signature of their client on the application because the client is in another city. This was handled by making the application "portable," which means that it can be

filled out by the applicant's attorney and e-mailed to the applicant for signature, and then returned to the attorney for filing at the USPTO. The portable form could also be used to save out a template for doing multiple filings.

- **Cost savings on Express Mail postage and fax charges and/or courier delivery costs.** By using TEAS, customers who file many applications each year can cut out-of-pocket postage and/or fax expenses for filing each application by $15-20.

The Numbers Speak for Themselves

It is one thing to make something *technically* feasible. It is another to convince customers that electronic filing is really in *everyone's* best interest. But 12 percent of USPTO's trademark filers can't be wrong! Since October 1, 1998, the USPTO has received more than 44,000 electronically-filed applications. In the first half of fiscal year 2000, the USPTO has already received as many electronically-filed applications as for all of fiscal year 1999, an increase of 100 percent. On a daily basis, TEAS filings have increased 480 percent, from an average of 26 per day in September 1998, to 152 per day in March 2000, seven days a week. By the end of fiscal year 2000, electronic filings should comprise 20 percent to 30 percent of the total number of trademark applications filed.

Making Frequent Filers into TEASers

To be considered successful, USPTO can't only attract new, one-time applicants for filing their trademark applications electronically. It must also see that the most frequent filers embrace TEAS. The fact that Mattel, Inc., the number one filer of trademark applications, now relies heavily on TEAS for submitting its initial applications demonstrates progress towards this goal. Mattel began using TEAS as a pilot participant and, since that time, has steadily increased its use of TEAS. In fiscal year 1999, Mattel filed 476, or 81 percent, of its applications electronically. For the first half of fiscal year 2000, Mattel filed 231 applications electronically. Clearly, Mattel finds substantial benefits in using TEAS.

If a major U.S. corporation that previously relied so heavily on the paper filing system could successfully transition to TEAS, other large filers will, in time, file electronically. To help promote TEAS to local bar groups throughout the country, USPTO is using "TEAS TOUR 2000," a series of presentations on electronic filing. Although the legal community may fear that the USPTO is attempting to divert their business, this is far from true. While the USPTO *is* trying to provide better access to information and filing means to all customers via TEAS, lawyers can, and must, continue to serve an important role in the overall registration process. As one longtime trademark practitioner recently expressed upon the filing of three applications electronically, *"If you can get an old dinosaur like me to use TEAS, you will be fine."*

First-Time Users Speak Up

When TEAS went from a pilot program to one available worldwide, USPTO soon recognized that lack of access had previously limited the use of the application process. Based on electronic filings received, the agency realizes that it is now tapping into a totally new market, consisting primarily of first-time applicants filing without attorneys. Feedback received via e-mail clearly shows that customers are thrilled to discover TEAS. They are particularly pleased that they can access the TEAS site at any time, view help sections at the bottom of the web screen, and e-mail questions to a TEAS Help Desk. This is what some customers had to say:

"I was filling out the regular mail-in form with my sloppy handwriting and having difficulty understanding what to put in the spaces, when I came upon your direct online form. TEAS answered my questions . . . and took the tension away. Just when I thought government offices were more like turtles one of them pulls a rabbit out of the hat."

"What an easy to understand process. I just stumbled on the site through Yahoo and . . . was able to submit 3 applications within a short period of time. Excellent job."

"Let me congratulate you for the efficient and positive service that you offer to the people even outside of your country."

"I have never filed a trademark before, and did not use a lawyer or professional service to do this, but relied primarily on your online site. I am extremely impressed with the entire process. The USPTO online site is excellent!!! It is an excellent source for information, forms, resources and research. The next time you speak to Mr. Gore about his government to people initiatives, please tell him that I think that in the USPTO office, he has the model on which the other agencies should base themselves."

"Thanks for providing an easy to use process for searching the trade-

mark database and then submitting a trademark application. This was the nicest interaction I have ever had with the federal government."

"Your web-site is awesome! This is probably the most useful and best designed web-site that I have encountered on the internet. If only everyone could design their sites like yours, more people would be using the internet. Well, Thanks!"

Perspectives of Corporate Users

Novartis Corporation

"Through our close ties with the USPTO (having been an examining attorney earlier in my career), Novartis realized early on the major benefits of using the e-TEAS system and was one of the pilot participants in the program. As one of the largest life sciences companies in the world, Novartis has offices and subsidiaries all over the U.S. with worldwide headquarters in Switzerland. Consequently, almost all of the trademark applications filed in the U.S. require the signature of our corporate officers in Europe. Previously, this meant that we prepared a paper application on our word processing software and sent it via e-mail to our corporate headquarters. It then had to be printed, signed and either faxed or returned via courier to our U.S. office. We then used Express Mail to file the application in the PTO. The entire process usually took five to seven working days to complete. Not only did this process use up valuable time, we also had to bear the costs of numerous faxes as well as the fees associated with professional courier services and Express Mail.

"The TEAS system has saved us significant time and money and it is easy to use. Using TEAS, we draft the application on the TEAS website, save it and send it via e-mail to Europe, where it is opened, signed, saved, and returned to us, also via e-mail. Upon receipt, we are able to file the application electronically. The turnaround time on our applications has been cut to just a couple of days in most circumstances. In one urgent situation, we were able to draft, have executed, and file a trademark application at the Trademark Office in just over thirty minutes! The cost savings are quite significant as well since we eliminate the need for faxes, couriers and Express Mail. TEAS is quite an improvement over the previous system and Novartis has eagerly taken full advantage of it as a means of increasing value to our internal clients and, ultimately, our shareholders."

Mattel, Inc.

"Mattel has benefited greatly from the new TEAS system. The electronic system provides an excellent vehicle for preparing and filing applications by any company with in-house counsel. The USPTO has an excellent staff available as "customer support" for answering questions that may arise when using the system. Corporate support staff time saved in quick preparation, execution and sending of corporate applications electronically has made the system very valuable. We have been able to cut costs in mailing papers to the USPTO. Receipt of acknowledgment together with an assigned serial number is returned almost instantaneously for all applications sent. This further reduces administrative costs for Mattel. If we were to assign a grade for the customer service and efficiencies in using TEAS, it would be an A+."

Other Recognition of Success

TEAS is a major step towards world-class customer service. In fact, TEAS has already been acknowledged as such by *Yahoo Magazine*, an Internet industry watchdog, calling TEAS "one of the best sites on the web." Moreover, the TEAS program has been selected as a semi-finalist in the *2000 Innovations in American Government Awards Program*, an awards competition sponsored by The Ford Foundation, The John F. Kennedy School of Government at Harvard University, and The Council for Excellence in Government). Fewer than eight percent (only 100 programs from the initial pool of 1,317 applicants) advanced to the semi-finalist selection round. In late May, 25 finalists will be selected, competing for $100,000 grants from the Ford Foundation.

Enhancements to TEAS

In April, the USPTO expanded TEAS to permit electronic filing of nearly all of the forms required for renewing, perfecting, and maintain-

ing trademarks. These include:

- Allegation of Use (Statement of Use/Amendment to Allege Use),
- Request for Extension of Time to File Statement of Use
- Section 8 Declaration,
- Section 15 Declaration,
- Combined Section 8 Declaration/Section 9 Renewal,
- Combined Sections 8 & 15 Declarations, and
- Requests to Divide.

Total trademark practice, from start to finish, and everything in between, is just a click away at the Trademark Electronic Business Center (http://www.uspto.gov/web/menu/tmebc/index.html.) The Trademark Electronic Business Center provides a single place to search trademarks, make trademark filings through TEAS, and check the status of pending applications.

Looking to the Future

The most significant remaining shortcoming of the TEAS program, but one that USPTO already has plans for addressing fully, is that TEAS stops at the office's front door (or, in this case, computer server). While USPTO currently can *accept* electronically-filed applications, it cannot handle these applications electronically through the entire trademark application process. Once a customer submits an application via the Internet through TEAS, and the application successfully arrives on the USPTO server, trademark staff must still print a paper copy and place it in a paper file jacket. The existing office environment dictates this approach, since customers still file the majority of their applications through the traditional paper system. To integrate the electronically-filed applications into the existing process, staff must convert the applications from the electronic format into a paper file.

The USPTO clearly recognizes the anomaly of encouraging TEAS filings, only to convert these electronic applications to paper ones; therefore, the agency has established long-range goals to develop a complete electronic examination process. In the future, an application will be submitted electronically; reviewed on-line, using e-mail for all correspondence with customers; made available for public review at the USPTO Web site in the *Official Gazette*, a weekly compendium of approved trademarks; and finally, issued as an electronic registration certificate.

In the interim, by entering TEAS data directly into computer systems, the office has made some progress towards reducing data entry errors and moved toward the ultimate paperless environment. In addition, a special "e-Commerce" office is projected to be operational in July 2000. This office will only handle electronically-filed applications and, by communicating with customers electronically, will build on the success of TEAS. Electronic communication will eliminate processing delays inherent in a paper system. USPTO will add more "e-Commerce" offices as TEAS filings increase.

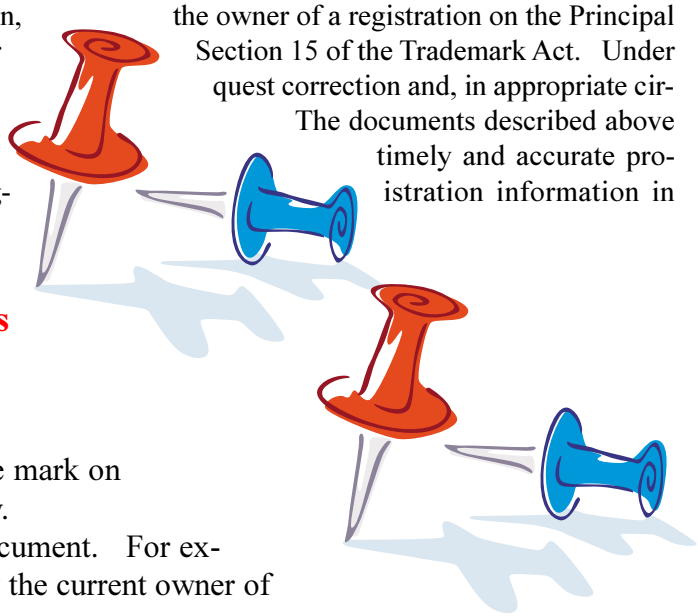
While the USPTO probably will always accept paper documents, the USPTO believes it is well on the way to having the *capabilities* to become a paperless office. Through TEAS, we have improved the relationship between the government and its citizens, expanding access to filers and providing more information for everyone. Now, "cutting edge" and "Trademark Operation" go hand-in-hand. The Trademark Operation will continue to "push the envelope"—but it won't be a paper one!

Karen Strohecker, Chris Doninger, Steve Meyer, Sharon Marsh, and Nancy Omelko contributed to this article.

Helpful Hints

for Trademark Applicants

Unlike copyrights or patents, rights in a federally-registered trademark can last indefinitely as long as the owner continues to use the mark to identify its goods or services and files all necessary documentation in the United States Patent and Trademark Office. In order to keep a registration alive, the owner of the registration must file, at appropriate times, 1) an affidavit of continued use or excusable nonuse under Section 8 of the Trademark Act which must be filed between the fifth and sixth anniversary of registration as well as every 10 years from the date of registration; and 2) an application for renewal under Section 9 of the Trademark Act which must be filed every 10 years from the date of registration. In addition, the owner of a registration on the Principal Register may file an affidavit of incontestability under Section 15 of the Trademark Act. Under Section 7 of the Trademark Act, the owner may request correction and, in appropriate circumstances, a change to the registration certificate. The documents described above are called "Post Registration Filings." To ensure timely and accurate processing of your post registration filing, and for post registration information in general, the USPTO offers the following tips.



Top 10 Tips for Post Registration Filings

by Hope Slonim, Office of the Commissioner for Trademarks

1 Include both the registration number and the mark on your papers; double-check them for accuracy.
2 Be sure that the proper party is filing the document. For example, a Section 8 affidavit must be filed by the current owner of the registration.
3 Use the Combined Section 8 Affidavit/Section 9 Renewal form when you renew your federal trademark registration.
4 Enclose the proper fee amount, if a fee is required. Please note that the fee for the Combined Section 8 Affidavit/Section 9 Renewal is $500 per international class of goods/services ($100 per class for the Section 8 ***and*** $400 per class for the Section 9). Failure to include proper fees may require a "deficiency fee" for correction.
5 File papers at the earliest possible time to avoid grace period and deficiency period fees.
6 For evidence of timely receipt in the USPTO, enclose a stamped self-addressed postcard, listing the complete contents of your filing (e.g. Section 8 affidavit, specimens, filing fee of $100).
7 To check status of a registered trademark, use TARR (Trademark Applications and Registrations Retrieval) on the USPTO web site at www.uspto.gov. In addition to status, TARR provides prosecution history, a listing of goods and services, and other key information.
8 Electronic filing of several post-registration documents will be available on the USPTO web site in spring 2000. Watch closely for this new feature!
9 For general information and filing forms, call the Trademark Assistance Center at telephone 703/308-9000.
10 For specific information concerning substantive requirements of post registration documents, call the Post Registration Division at 703/308-9500.

TESS -- TEAS -- TARR

Which One Does What?

by Jessie Marshall, Office of the Commissioner for Trademarks

The Trademark Operation has made three electronic systems available to the public at the USPTO Web site in a relatively short period of time. The public feedback about these systems has been very favorable and the Trademark Operation is justifiably proud of its achievements. However, unless a user is very familiar with the function of each of the systems, it's hard to remember which one does what. The acronyms don't give much of a clue, but TESS is not TEAS is not TARR. What to do? Perhaps the title of this article will help. The systems would most commonly be used in the order the are presented in the title: TESS -- TEAS -- TARR.

TESS -- TEAS -- TARR

Let's say you're interested in applying to register a trademark at the USPTO. What do you do first? You search the mark you want to apply for prior to filing your application. What on-line tool do you use to search it? You use TESS (that stands for Trademark Electronic Search System.) The TESS system provides you with the same information that is available in the USPTO for use by the examining attorneys in the office. It is updated daily and the basic search feature is quite easy to use.

Now that you've searched your mark and (hopefully) found nothing in a registration or a prior-filed application that you think could cause you a problem, you want to apply for your registration. And what's next in the title? TEAS!

TESS -- **TEAS** -- TARR

TEAS -- the Trademark Electronic Application System -- allows you to fill out a form and check it for completeness over the Internet. Using e-TEAS you can then submit the form directly to the USPTO over the Internet, making an official filing on-line. Or using PrinTEAS you can print out the completed form for mailing to the USPTO. It's your choice; but the USPTO encourages on-line filing since the data in the application can be entered directly into the USPTO database thus eliminating data entry errors. TEAS gives step-by-step instructions for completing a form properly. It also provides access to a wide variety of information about USPTO procedures and practice. While the different sections of the forms may appear straightforward and easy to fill out, you are strongly advised to read the HELP instructions very carefully for EACH section PRIOR to actually completing it. Failure to follow this advice may cause you to fill out sections of the form incorrectly, jeopardizing your legal rights.

Recently, the USPTO made all trademark forms available through the TEAS system. Now, all forms that previously had to be filed on paper through the mail, can be filled out and filed on-line. Forms now available are:

- Statement of Use/Amendment to Allege Use for Intent-to-Use Application
- Request for Extension of Time to File a Statement of Use
- Combined Declaration of Use & Incontestibility Under Sections 8 & 15
- Declaration of Use of a Mark Under Section 8
- Combined Declaration of Use in Commerce/Application for Renewal of Registration of Mark Under Sections 8 & 9

- Declaration of Incontestability of a Mark Under Section 15
- Request to Divide

For more information concerning any of these forms, go to http://www.uspto.gov/teas/eTEASforms.htm.

Your application has been entered into the USPTO database and assigned a serial number. Then what? You want to know what's happening to it. To do that, use TARR.

TESS -- TEAS -- TARR

Using the TARR -- Trademark Application and Registration Retrieval system -- you may retrieve information about pending and registered trademarks obtained from the USPTO's internal database by simply entering a valid trademark serial number or registration number. Enter a serial number or registration number (without punctuation of any kind -- commas, slashes, etc.) and you get the following information:

- Word mark
- Current status (in plain English)
- Date of status
- Filing date of the application
- Current owner
- Goods and services
- Prosecution history

There are a few important things to be aware of when using the TARR system.

The USPTO's trademark information on the Web is updated daily at 5:00 a.m., EST. The TARR database does not include any newly-filed applications or amendments to existing applications entered into the USPTO's internal trademark database after the last TARR update. For example, the TARR database shows applications that registered after its last update as pending applications rather than registrations. The TARR database does not include edits made to individual records after its last update.

The fact that a mark is not present in the TARR database does not necessarily mean that the mark is not currently being used as a trademark. The TARR database contains only those trademarks that are federally registered or that are pending (applications undergoing examination at the USPTO). The TARR database does not contain any information on state, foreign, or common law trademarks.

So say it three times: TESS -- TEAS -- TARR, TESS -- TEAS -- TARR, TESS -- TEAS -- TARR. And remember the order:

1. TESS - Search
2. TEAS - Apply
3. TARR - Retrieve information

Of course, there's no set order for using the systems. Use them when and how you need them. This is just a way that may make it easier to remember the acronym that stands for the system you want to use. All of these systems are easily accessed at the USPTO home page (www.uspto.gov). They are all presented under the Trademark link from the home page. But they are also presented under the Trademark Electronic Business Center (TEBC) link. If these are the on-line services you're looking for, it's easiest to go the TEBC where all of the systems are explained and the words behind the acronyms are written out.

However, when in doubt, remember:

TESS -- TEAS -- TARR!!

Art and Trademarks

by Jessie Marshall, Office of the Commissioner for Trademarks

Art and trademarks - what do they have in common? In the realm of the visual arts and the written word, they create a Janus-head, the same concept looking in two directions. Trademarks are art – designs and words. Their purpose is commercial while the purpose of art is aesthetic or educational. Trademarks are words, symbols, or combinations of the two. Visual art is words or symbols and often a combination of the two. Even the performing arts are composed of words and symbols, and recently marks that move have been registered at the United States Patent and Trademark Office. Marks that appear in the leader to a movie or on an Internet Web page are dynamic marks whose very movement creates the commercial impression recognized by the public. The electronic age has brought the worlds of art and trademarks even closer together.

In order to understand the significance of the intersection of the trademark world and the art world, we should start at the beginning – about 7000 years before the Lanham Act was a gleam in anyone's brain.

The importance of trademarks can be said to date back to about 5000 B.C. when drawings showing bison with symbols on their flanks appeared in the caves of prehistoric man. It is interesting to note that this first example of a trademark is in the context of the earliest works of art we know. While it is possible that the symbols could have some entirely different meaning, it is not a great stretch of credibility to believe that they were some kind of ownership mark, that is, a trademark that identified those particular bison as being the property of a unique owner and distinguishing those bison from the bison of others. How familiar that characterization is to those of us steeped in the trademark law of the 20th century that defines a trademark as a word, name, symbol, or device used by a person to identify and distinguish his or her goods from those of others.

By 500 B.C., a real economic use of trademarks can be documented in ancient Rome where evidence has been found of bricks stamped with the mark of the brick manufacturer. Rome was the age of monumental buildings and great architecture. The creators of these edifices would have been quite concerned with the quality of the materials they were using. How better to insure getting the same high quality than to be able to identify materials produced by a manufacturer that had provided high quality goods in the past. However, as with all other intellectual pursuits, there is very little to be found about the use and growth of trademarks during the period between the fall of the Roman Empire and the Renaissance. Art and architecture tended to be created by groups – cathedrals, tapestries, hymnals were worked on over many years with many hands contributing to the finished product. Since the concept of guilds was still developing, these creations often have no attribution. The names of so many artists are lost to us. As they are lost, so are any commercial uses that might have been made of words or symbols to identify goods of a particular producer are lost.

But with the Renaissance, the age of imagination, free-thinking and a celebration of the arts that lasted centuries, trademarks re-emerged in a significant way. In about the 12th century, trade guilds began using marks to identify goods made by their members. In 1266, the year before the birth of Giotto, the earliest English law on trademarks – the Bakers Marking Law -- came into being. This law allowed bakers to identify their breads by stamping a mark on the loaf or pricking the loaf in a particular and recognizable pattern.

But the High Renaissance is the era when names and the works they identified became vital in both the arts

and commerce. The names of the artists of the Renaissance wash over us with immediate images of quality and style. Botticelli, della Francesca, Michaelangelo, Da Vinci, Raphael, Titian – works of art with these names affixed on them mean quality and the names themselves imbue them with a commercial worth that would not otherwise exist. The value of name recognition extended into the commercial community and trademarks proliferated. Laws concerning them became stricter. The first reference to trademark infringement litigation occurred in 1618 when a clothier who produced inferior cloth used the mark of a superior cloth producer and was brought to court in the case of Southern v. How.

In the United States during the 18th and 19th centuries, the birth of our nation and the birth of an American sensibility in art coincided. It was the time of Gilbert Stuart, Benjamin West, John Singleton Copley, and John Singer Sergeant. Many of these American-born artists moved to Europe after their early years in the United States. As they took their new way of looking at the world to the Old World, a new way of looking at commerce and economics crossed the Atlantic as well. The origin of American trademark protection came in the sailcloth manufacturing industry. As a result of concerns of sailcloth makers, Thomas Jefferson recommended the creation of trademark legislation based on the commerce clause of the Constitution in 1791. In 1870, the United States finally enacted trademark legislation based on the patent and copyright clause of the Constitution. That law was later repealed because of its inappropriate constitutional underpinnings, but the first registered trademark in the United States registered under that law. The mark was dominated by the depiction of an eagle and was used to identify liquid paint produced by Averill Paints. While this paint was intended primarily for houses and other external uses, it is interesting to note that even the first registered trademark in the United States has a nexus with the art world. Finally, in 1881 trademark legislation was passed that was properly based on the commerce clause of the Constitution as originally suggested by Thomas Jefferson almost a century before.

The 20th century brought a new economic world with the industrial age and a new world in art with Cubism, Abstract Expressionism, and Pop Art. As the economic world became more organized with corporations and improvements in the trademark registration system, the art world was breaking itself down into its component parts through the Cubist vision of Braque and Picasso and making those parts art itself in the realm of the Abstract Expressionism of Rothko, Motherwell and Frankenthaler. But the two came together as never before through the Pop Art of Warhol, Oldenberg, and Lichtenstein. Now trademarks were art. The marks and the goods identified by those marks were incorporated into the works of these artists because of the enormous public recognition these words, symbols, and goods had. This growing sensitivity to the power of trademark recognition made trademarks even more important to the economic life of the United States.

And what will the 21st century bring? We see trademarks and their power in cyberspace already. They emerge as an art form as they are incorporated into the design of Web sites on the Internet and repeated as background elements in video monitor wallpaper. But it is as impossible for us to guess what this century will bring as it would have been for the framers of the first U.S. trademark act to guess what the 20th century would bring. There are new technologies to be developed (and patented) that may enable us to create forms of art that are not possible and not dreamed of now. Sophisticated computer graphics programs make it easy for non-experts in computer programming to create fascinating and innovative artistic elements. Perhaps 3-dimensional, projected holograms will become a popular art form of the 21st century. Imagine those holograms used as trademarks. Someone may be walking through a supermarket in 2099 and have floating images of trademarks wafting around him or her. With art as with trademarks, the inventiveness of the human mind is the only boundary. And, from cave paintings to repeated soup cans, the human mind knows no creative limit.

An Inside View

Anne H. Chasser comments on her first six months in charge of the Trademark Operation

Do you remember ever taking a field trip in school to a local dairy, or chocolate factory, or museum? Or, perhaps you've watched a documentary on television about how a movie is made. You found out the "behind-the scenes" operations that bring the milk, the candy, the exhibits, or the movie to the public. Since coming to the United States Patent and Trademark Office a few months ago, I have been given the extraordinary opportunity to see all of the "behind-the-scenes" activities of the Trademark Operation.

For more than 20 years, I have worked in the trademark field, primarily developing a college licensing program at The Ohio State University. As a long-time customer of the USPTO, I was interested really in only one part of the process: the final product. As long as I was able to receive a trademark registration, I wasn't tremendously concerned about the way in which the registration evolved.

As commissioner for trademarks, I am responsible for much more than just the "end product." In fact, as everyone in Trademarks knows, the registration certificate is by no means the whole story. From the mailroom, to pre-examination, the law offices, post registration, and cyberspace, the work of the employees in the Trademark Operation is sophisticated and complex. I would like to share with you just a few of the "behind-the-scenes" tidbits I've found after spending the last six months at the USPTO, listening and learning.

Dedicated Employees

The first thing I discovered is that USPTO employees are tremendously dedicated. They want to do the right thing and strive for continuous improvement. I was delighted to find that everyone has a genuine appreciation for their work. Employees generally know where their jobs fit in to trademark workflow and have good ideas about improving both their own work processes and the work processes of others in the operation.

Facing a Growing Workload

In business, when there is more demand, there are usually several options: You can hire more people, you can increase production, you can raise prices in response to demand, or you open more operating facilities. The USPTO has a huge workload. In fact, trademark applications have increased by nearly 40 percent in the first half of this fiscal year. Unlike business, however, we can't just raise prices when demand is high, we can't just hire people. Even though faced with a huge workload and denied some of the solutions traditionally available to business, trademark employees are coming up with better ways to get the job done.

Performance-Based Organization = Opportunities for Employees to Shine

It has become clear to me that the USPTO leads the world in providing customer-valued federal trademark regis-

trations. That is why I am excited about the change that took place on March 29, 2000, transforming the USPTO into a performance based organization. It is an organization based on results. Clear objectives, measurable goals, and world-class customer-service standards are precisely the means by which the outstanding qualities of USPTO employees can be demonstrated to the world. When an organization is as fortunate as the USPTO in terms of human resources, all it needs to ask is "How high can we reach?"

Clear Goals = Clear Direction

Delineating expectations is critical. It is almost impossible to do your best if you don't know why you are doing something. I want to ensure that every employee in the Trademark Operation knows the customer satisfaction, employee satisfaction, quality measures and processing-time goals for the Trademark Operation.

I realize that I bear primary responsibility for the successes and shortcomings of the Trademark Operations. If we are to be a successful performance-based operation, my goals must be clear and well-defined. In addition to the traditional USPTO goals of high quality and low pendency, my personal goals are communication and understanding. Communicating the technical, procedural, legal, and customer-service needs of our organization is critical to our ability to reach our goals. Understanding customer concerns, needs, and listening to customers' recommendations will ensure that we reach our performance goals as a successful team.

I look forward to hearing from you.

Anne H Chasser

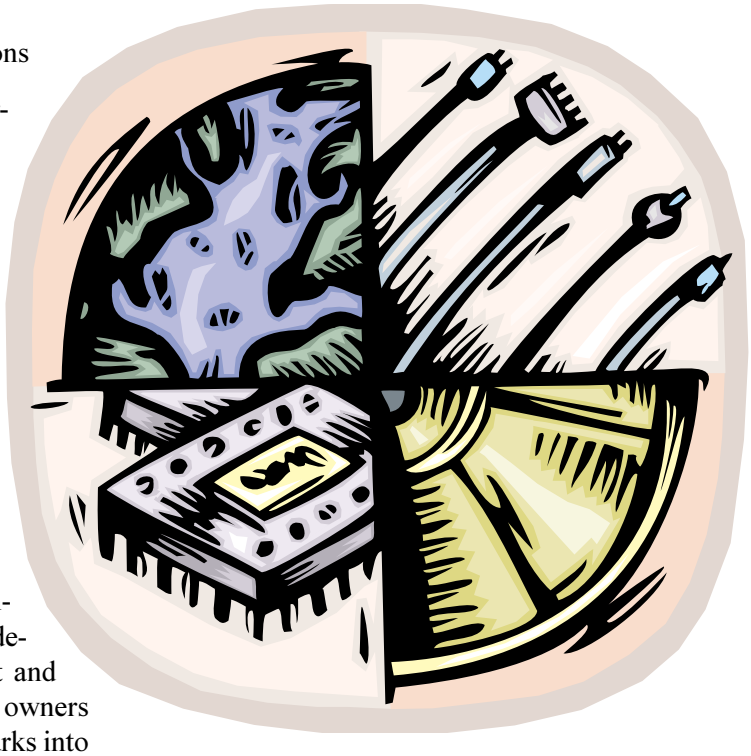
Teaching young people the importance of intellectual property gives Chasser an opportunity to enjoy the lighter side of her job.

Above: Under Secretary Dickinson and Commissioner Chasser pose with the Jolly Green Giant. The USPTO was host to the grand prize presentation ceremony for the Green Giant National Veggie Eating Invention Contest for kids in the Patent and Trademark Museum.

Left: Commissioner Chasser explains trademarks to sons and daughters of USPTO employees during Take Your Kids to Work Day.

Trademarks and E-Business --

by Jessie Marshall, Office of the Commissioner for Trademarks



In the first half of fiscal year 2000, applications for trademark registration have increased 39 percent over the same period last year. The total number of classes in trademark applications that were filed in fiscal year 1999 was 295,000. If application filings for the rest of fiscal year 2000 continue at the present increased level, approximately 410,000 classes will be included in fiscal year 2000 filings. Where has it all come from? How long will it continue? Why? The answer to these questions can be answered in one word: E-business.

Actually, more than one word is needed to try to explain this phenomenal growth. Certainly the booming economy has contributed to the increase in the number of applications filed for trademark registration at the United States Patent and Trademark Office. Well-established trademark owners are pouring new products bearing new trademarks into the fecund economy. New entrepreneurs are launching new ventures into the healthy commercial environment the United States has enjoyed for the past few years. But the single biggest factor in the increase must be the explosion of commerce on the Internet and the businesses taking advantage of that explosion. And the realization by those businesses that the name by which they are known on-line is a vital key to their commercial success.

Protection of that vital key becomes of utmost importance. That's where the federal trademark registration system comes into the picture. The latest Uniform Domain Name Dispute Resolution Policy (UDRP) developed by Internet Corporation for Assigned Names and Numbers (ICANN) does not require that a trademark or service mark be registered in order for a complainant to invoke its provisions. It merely requires that the domain name be "identical or confusingly similar to a trademark or service mark in which the complainant has rights." However, a negative decision by the mandatory administrative proceeding required by the UDRP can be submitted to a court for independent resolution. Once in the U.S. court system, the benefits of having a federal trademark registration come into play with all of its accompanying power and presumptions.

So it becomes of utmost importance that an e-business register at least the second level of its domain name, if not the entire name, as a trademark. Of course, the domain name must be functioning as a trademark -- a source identifier -- and not just as an address -- a source locator. The USPTO has prepared an extensive examination guide on the subject of examination of domain

Vital Partners in the 21st Century

names presented for trademark registration. (See http://www.uspto.gov/web/offices/tac/notices/guide299.htm) Assuming the domain name passes the test of being used as a trademark or service mark, the registration of that identifier with the USPTO should be as much a part of a business plan as obtaining venture capital and having a great Web site.

Many e-businesses have recognized that step. The USPTO has over 15,000 pending applications that include .COM in the marks. It has registered 817 .COM marks. These figures don't include applications for second level domain names that don't include the .COM in the mark. Given the millions of domain names in use on the Internet, this represents a very small percentage of those names. Where is everybody? The USPTO has seen some of these domain names as the subject of trademark registration applications, but probably not all that it should.

Unfortunately, many businesses that were established before the electronic age are technophobic. They may have taken the plunge and put a Web site on the Internet, but other aspects of cybercommerce, such as registration of their domain name as a trademark, become an insurmountable challenge. Some may already have a federal trademark registration but it may cover very different goods or services than those that are being offered on-line. They may not realize that a new trademark registration should be obtained, if possible, that includes these new goods or activities.

Another reason may be that, like traditional businesses, many e-businesses don't recognize the importance of having their identifying name registered as a trademark if that's possible under the Trademark Act. The USPTO gets dozens of telephone calls everyday from people who have been using a mark for years but haven't obtained a federal registration for it and have just found out that someone else has registered a similar mark for related goods or services. When asked why, these frantic entrepreneurs say that they didn't want to spend the money to register their marks, or they thought it was too difficult or, sometimes, that they didn't even know that there was a federal registration system. There's no reason why e-business entrepreneurs should be any different. However, the USPTO has tried to make its system more available and more user-friendly through its on-line application system called e-TEAS (See http://www.uspto.gov/teas/index.html). Hopefully, on-line businesses will be savvy enough to find and use this site since they have a degree of comfort in the world of cyberspace.

A final word of advice to e-businesses: register your domain names as a trademark early and often -- at least as permissable under the Trademark Act. Trademark registration and domain names are not a perfect match. Their purposes are different and often they are used in different ways. But where they overlap, the interrelationship is so very important, a successful e-business can't afford to ignore or minimize the benefits of registering its domain name as a trademark with the USPTO.®

Trademark Factoid:

The mark VELCRO was registered on May 13, 1958 for hook & loop fasteners.

It's TLT for the USA!

by Lynne Beresford, Office of Legislative and International Affairs

photo: Dennis Forbes

Judge Carlisle Walters, Trademark Trial and Appeal Board, and Lynne Beresford, Office of Legislative and International Affairs, with a copy of the TLT ratification document.

The Trademark Law Treaty (TLT), concluded in 1994, provides standards for the simplification and harmonization of procedures used in obtaining and maintaining trademark registration. On April 10, 2000, President Clinton signed the TLT ratification document on behalf of the United States. The United States deposited its instrument of ratification with the World Intellectual Property Organization on May 10, 2000. By joining the treaty, the United States confirms its commitment to simplified and harmonized trademark filing and maintenance procedures and to enhanced protection for intellectual property throughout the world.

Work on the TLT began in 1987 with the adoption by the Governing Bodies of the World Intellectual Property Organization (WIPO) and the International Union for the Protection of Industrial Property of a proposal to begin work on harmonization of certain legislative provisions for the protection of trademarks. The first Committee of Experts on the Harmonization of Laws for the Protection of Marks was held in November of 1989.

The Committee of Experts met six times in the years between 1989 and 1993. Early meetings focused on both substantive and procedural aspects of trademark law. However, it became apparent that if progress was to be made, the Committee of Experts should focus only on the harmonization of trademark procedures. A diplomatic conference was held in October 1994 to create the final version of the proposed treaty. The diplomatic conference concluded with a "final act" adopting the treaty on October 27, 1994. The treaty was opened for

signature on October 28, 1994, and at that time 35 countries, including the United States, signed the treaty.

The TLT primarily regulates and simplifies the procedures of the Trademark Offices of the member countries. TLT effects simplification by establishing maximum lists of requirements for certain standard trademark procedures such as filing an application, filing an assignment, appointing a representative, and changing the address of record. A trademark holder or its representative submitting a request for registration, for recordal of an assignment, for a change of address, or for appointing a representative, need submit only the information which satisfies the elements from the relevant maximum list, with the correct fee and in the correct language, and the Trademark Office must accept and process the filed document. The TLT also provides suggested forms on which to make such filings. However, the TLT does not harmonize the languages of filing, so an applicant must apply in the language appropriate for the office to which it is sending its application. In order to effect these changes, the legislation focuses on the procedural aspects of the Lanham Act and leaves the substantive law relatively untouched.

The TLT further provides that member countries must accept multi-class applications. The ability to have a multi-class application which matures into a multi-class registration is of great practical significance to those who must maintain such registrations. For example, with a multi-class registration there is one date for renewal for all the classes. If the applicant was forced to seek single class registrations then each registration might have a different renewal date. Further, a multi class-application can be assigned with a single request, whereas individual registrations might require separate requests.

Member countries must accept service mark applications. Given the importance of services to the U.S. economy, the ability to protect service marks is an important one.

Member countries must accept simple signatures on almost all trademark documents filed with the member offices. The current necessity to legalize and authenticate trademark documents adds unnecessary complexity, expense and burden to the process of obtaining and maintaining a trademark. Eliminating those needless formalities will be an enormous step in the direction of a rational trademark system.

Finally, a trademark owner and its representative will be able to record an assignment, a change of name, or a change of address for all of its trademark applications and registrations by filing a single request.

For trademark owners in the United States, the TLT offers multiple benefits. The use of standardized forms should make prosecuting trademark matters in other countries simpler and possibly cheaper. The ease with which standard trademark procedures can be carried out should also benefit trademark owners.

Finally, most of the benefits available under TLT will require no changes in U.S. law or practice because most of the Trademark Act is fully compatible with the TLT.

For more information concerning how the TLT provisions have been incorporated into the Trademark Operations processes, please refer to Examination Guide 3-99 that is available at the USPTO web site at http://www.uspto.gov/web/offices/tac/notices/guide399.htm.

Feature

Law Student Interns Gain Experience - Improve Operations

by Thomas Shaw, Managing Attorney, Trademark Law Office 102

The Trademark Office Law Student Intern Program

One of the great hurdles facing law students is converting their academic experience into a paying job. Many employers won't hire applicants without demonstrated experience while students can't get practical experience without first getting hired. It's a "Catch –22" situation for aspiring law students.

Fortunately, the Trademark Office Law Student Intern Program can help solve this problem. Each semester, the trademark office hires 10-12 volunteer law student interns to assist in examining trademark applications. The interns perform a variety of research tasks for the examining attorneys, the Office of the Commissioner for Trademarks, and the Trademark Trial and Appeal Board. Although the interns generally can't be paid, many law schools have supervised externship programs, which allow students to get academic credit for their work.

On their first day of work, the interns attend a one-day orientation program to introduce them to the basic operation of the office and the examination of trademark applications. Following the orientation, the interns work with the program coordinator and the attorneys requesting the research. The nature of the work performed by the interns is extremely varied and often presents interesting challenges. Besides the usual case law research, interns routinely use Lexis/Nexis or surf the Internet to find evidence to decide whether marks can be registered. Interns frequently visit local retail stores to request permission to photograph merchandise for product configuration cases. Several years ago, one intern even helped redraft several sections of the Trademark Manual of Examining Procedure for the Office of the Assistant Commissioner. Interns also have helped reduce correspondence backlogs in the Intent to Use and Post-Registration sections.

The trademark office benefits greatly from the intern program in a number of ways. Most importantly, each semester, the office gets thousands of hours of high-quality legal research at a minimal cost. This allows the examiners to do more work in less time by delegating time-consuming evidentiary research to the interns. The intern research also improves the quality of office actions because they can spend more time and effort in collecting hard-to-find evidence. Applicants benefit from the intern program because better evidentiary and case law research leads to more accurate examination of their applications.

Working for the trademark office gives law student interns a solid grounding in trademark law by emphasizing the basics of trademark examination. By the end of the semester, the interns will have worked with attorneys on every major refusal the office makes. They also have the opportunity to see how the various parts of the office interact by doing occasional work in the Intent to Use and Post-Registration sections or by observing TTAB hearings.

The intern program also provides the office with an enthusiastic pool of candidates for examining attorney jobs. Many interns enjoy working for the office and apply for examining attorney positions after graduating from law school. Today, over 20 former interns are working as examining attorneys.

In order to work as an intern for the office, students: 1) must be U.S. citizens, 2) must be willing to work for free or for academic credit, and 3) must be working toward a degree at a law school. Additional information about the intern program will be posted on the USPTO Web site.

Interns may also have an opportunity to share their talents in other areas of the USPTO such as the Patent and Trademark Museum. Michelle Massicotte worked on the exhibit team during the summer of 1998 researching the history of trademarks and selecting appropriate marks for inclusion in the exhibit. Michelle is pictured here with Isaac Fleischmann, to whom the museum is dedicated, at the opening of the exhibit "The House That Innovation Built."

Michelle graduated from the Dickinson School of Law of the Pennsylvania State University in May 1999. She moved to Washington, D.C. to continue her internship while studying for the Massachusetts Bar exam. She was hired as an attorney at the USPTO in August 1999, passed the bar on the first take, and is currently an examining attorney in Law Office 115. "My series of internships affirmed my interest in trademark law and strengthened my experience beyond any course I could ever have taken in law school. In sum, I have the USPTO internship program to thank for my career in trademark law."

Editor's Note: On June 2, Isaac Fleischmann celebrates his 90th birthday. Isaac is the former director of public affairs for the USPTO. He retired in 1981 but has remained active in the intellectual property area, especially teaching the value of patents, trademarks, and copyrights to young people. To those of us who have known Isaac over the years, he is a dear friend and mentor; if you don't know him, I wish you the privilege of meeting him. Happy Birthday, Isaac... we love you.

Official Insignia of Native American Tribes

The USPTO At Work For All Americans

by Eleanor Meltzer, Attorney-Advisor, Office of Legislative and International Affairs , and Andrew Lawrence, Senior Attorney, Law Office 108

Background

On October 30, 1998, President Clinton signed Public Law 105-330. Title III of this law required the USPTO to study how the official insignia of Native American tribes may be better protected under trademark law. The new law mandated that the Commissioner of Patents and Trademarks* complete the study and submit a report to the chairman of the Committee on the Judiciary of the Senate and the chairman of the Committee on the Judiciary of the House of Representatives, not later than September 30, 1999.

Two facts emerged from the seven-month-long study. First, few commentators appeared to fully appreciate the scope of protection and law enforcement already available with respect to misrepresentation of Indian-produced goods. Second, the comments received to this study made manifest both the need for better use of existing prohibitions and for education about the options available to Native American tribes to enforce their intellectual property rights and protect their cultural heritage.

Based on the comments received, the following recommendations were made:

1. An accurate and comprehensive database containing the official insignia of all state and federally recognized Native American tribes should be created.

2. The U.S. Patent and Trademark Office should create, maintain, and update this database.

3. Relevant federal agencies should work cooperatively to educate and assist Native American tribes in their efforts to protect their official insignia.

4. Relevant federal agencies should work cooperatively to educate the public at large with respect to the rights surrounding official insignia of Native American tribes.

Scope of the Study

The study was required to address a variety of issues, including:

- the definition of "official insignia" of a federally and/or state recognized Native American tribe;

- the impact of any changes on the international legal obligations of the United States; and

- the administrative feasibility, including the cost, of changing current law or policy in light of any recommendations.

The USPTO published two Federal Register notices requesting comments on a variety of issues. The first notice was published on December 29, 1998, (63 FR 71619-71620), and requested comments on how best to conduct the study, where public hearings should be held, and who should be consulted during the study process. The second notice, published on March 16, 1999 (64 FR 13004-13005), requested the public's views on all aspects of trademark protection for the official insignia of Native American tribes. Thirty-three different groups submitted written comments, some responding to both notices.

**Title since changed to Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

In response to comments received, public hearings were announced in the Federal Register (64 FR 29841 June 3, 1999, and 64 FR 32037 June 15, 1999). The hearings were held in three locations in the United States: Albuquerque, New Mexico on July 8, 1999; San Francisco, California on July 12, 1999; and Arlington, Virginia on July 15, 1999. A total of 36 groups and individuals provided oral testimony (20 in Albuquerque, 3 in San Francisco, and 13 in Arlington).

The Federal Register notices related to this study, the transcripts of the three public hearings, and all written comments received prior to July 15, 1999, were posted for public viewing on the USPTO's Website at: www.uspto.gov.

What the Study Did Not Cover

The commissioner was charged specifically with studying the trademark issues surrounding the protection of the official insignia of federally and state recognized Native American tribes. All responses received in connection with the Federal Register notices and public hearings were reviewed and considered except those that went beyond the scope of "official insignia," even if those issues involved trademarks. For example, issues regarding the propriety of wearing "war bonnets," garments, headdresses, jewelry, and craft items associated with Native American tribes; of writing inaccurate or disparaging comments about Native Americans; and of making oral comments that denigrate Native Americans, were raised in the written and oral responses received in connection with this study but go beyond the scope of "official insignia." Many respondents pointed to legitimate social ills having real consequences for the welfare of Native Americans.

An instructive example of the limited scope of this study is the recent decision in *Suzan Shown Harjo, et al v. Pro-Football, Inc.,* 50 USPQ2d 1705 (TTAB 1999), currently on appeal in a civil action to the U.S. District Court for the District of Columbia. Coincidentally, the Trademark Trial and Appeal Board (Board) of the USPTO issued its final decision during the pendency of this study. The Board held that the term "redskins" was disparaging to Native Americans, and was disparaging at the time applications for registration of the term "Redskins" were submitted to the USPTO. Therefore, registration of various trademarks containing the term "redskins" was held to be in violation of Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), and the marks were ordered canceled.

Registration No. 2,029,471
Oneida Indian Nation

Registration No. 1,930,536
Pueblo of Pojoaque

Even though the "*Harjo*" decision involves both trademarks and a reference to Native Americans, it was outside the issues under review in this study. The term "redskins" is not the name of a Native American tribe. Neither the term "redskins" nor the logos associated with the term are emblems associated with or claimed by any Native American tribe. The issues in the "*Harjo*" decision fall in the category of "other social ills" which may have trademark implications, but which do not involve "official insignia of Native American tribes."

USPTO's Current Activities With Respect to Trademarks and Native American Tribes

At the public hearings, the USPTO provided the following information regarding its current activities with respect to trademarks and Native American tribes.

<u>The USPTO Is Not a Law Enforcement Agency</u>

The USPTO is not a law-enforcement agency like the FBI or U.S. Customs. It is specifically charged with examining and registering trademarks, as well as examining and issuing patents. The USPTO does not police the use of trademarks in commerce. The Trademark Act of 1946, as amended, 15 U.S.C. § 1052 *et seq*, explicitly prohibits registration of marks which "may dis-

parage or falsely suggest a connection" between the applicant and another person, institution, belief, or national symbol. 15 U.S.C. § 1052(a).

The USPTO Takes An Active Role In Protecting Native Americans

In 1994, the USPTO contacted every federally registered Native American tribe in order to compile a list of "official insignia" so that the office might better uphold the letter and spirit of the Trademark Act. The office sent out letters to more than 500 federally recognized tribes; approximately 10 responses were received.

Despite the low response rate, the USPTO has taken steps to ensure that third parties do not register trademarks that give a false impression of the true origin of the goods or services. Since 1994, all trademark applications containing tribal names, recognizable likenesses of Native Americans, symbols perceived as being Native American in origin, and any other application which the USPTO believes suggests an association with Native Americans, are examined by one attorney who has developed expertise and familiarity in this area. The USPTO refuses many applications incorporating the names or symbols of Native American tribes. (See, for example, Application Serial No. 75-265350, ["ZIA SYSTEMS" with Zia Sun Symbol design, for "stationery, computer software products and packaging, and advertising," refused on the basis of likely false association with the Pueblo of Zia]; Application Serial No. 75-447770, ["ZIA" with Zia Sun Symbol design, for "cocktail mixes," refused on the basis of likely false association with the Pueblo of Zia and possible disparagement of the tribe]).

In addition to its practice of careful examination of applications by its trademark examining attorneys, the USPTO has additional systems in place to safeguard against parties obtaining trademark rights to which they are not entitled. The "Letter of Protest" procedure as well as opposition and cancellation proceedings provide third parties the opportunity to challenge USPTO actions in trademark cases.

Proposed Definition of "Official Insignia of Native American Tribes"

Based on the comments received and in light of significant body of case law interpreting Section 2(b) of the Trademark Act, the USPTO proposed the following definition of "Official Insignia of Native American Tribes:"

"Official Insignia of Native American Tribes" means the flag or coat of arms or other emblem or device of any federally or State recognized Native American tribe, as adopted by tribal resolution and notified to the U.S. Patent and Trademark Office.

The proposed definition was intended to incorporate wording found in Section 2(b) so that the presumptions and interpretations arising out of Section 2(b) would apply to "Official Insignia of Native American Tribes."

Amendment of Section 2(b) was not recommended, for the following reason: Presently, Native American tribes may register their official insignia as trademarks, obtaining all the benefits of federal registration. Protection exclusively under Section 2(b) of the Trademark Act would prohibit tribes from obtaining federal trademark registration for their official insignia. By defining "official insignia" with reference to the wording mark Act, the "official insignia" of Native American tribes are identified as emblems of governmental authority without prohibiting their use, if desired by tribes, as proprietary commercial properties.

Consistent with current practice under Section 2(b), words alone would not be considered "Official Insignia of Native American Tribes." For example, the word "France" is not considered an "insignia" of France under Section 2(b), so that inclusion of the word "France" in a trademark does not violate this section of the Trademark Act. (See, for example, U.S. Registration No. 1,014,221 ("VIE DE FRANCE")).

Some commentators indicated that there was no possibility of "good faith" use of the names of Native American tribes, except by Native Americans. However, the study pointed out that developments in the English language in American history have resulted in some Native American tribal names acquiring meanings beyond their significance as names of tribes. Many words identifying Native American tribes are also incorporated in trademarks and used worldwide to identify both the geographic place named and, separately, a particular Native American tribe.

Some Native American tribal names also have meanings in other languages as, for example, the name of the Zia Pueblo in New Mexico. The word "ZIA" means "aunt" in Italian. See U.S. Trademark Registration Nos. 1,779,871 ("ZIA MIA" for restaurant services, with a translation statement indicating that the words "ZIA MIA" in the mark mean "my aunt."); 2,061,921 ("ZIA

MARIA'S" for salsa and spaghetti sauce, with a translation statement indicating that the term "ZIA MARIA'S" may be translated from Italian to read "Aunt Maria's.")

A *per se* prohibition on registration of the names of Native American tribes could create gross unfairness to trademark owners using names that happen to intersect with those of Native American tribes. These entities have no intention of falsely associating themselves with Native American tribes and are in no way actually associated with Native American tribes in the mind of the consuming public.

What Happens Now?
The USPTO is currently printing bound copies of the report. The office is also organizing a process by which Native American tribes can report their official insignia to the USPTO. When the bound copies are received, they will be sent to each of the over 560 federally and state-recognized Native American tribes. The copies will be accompanied by a cover letter that summarizes the report, provides guidance on what is meant by an "official insignia," and which provides guidance on notifying official insignias to the USPTO.

If you would like to review the report and underlying *Federal Register* notices, here is the link to our Website: http://www.uspto.gov/web/menu/current.html#register. For specific information, please contact Eleanor Meltzer at: eleanor.meltzer@uspto.gov or by telephone at: (703) 306-2960.

Faces of the USPTO

Robert M. Anderson became the deputy commissioner for trademark operations on March 29, 2000, after serving as deputy assistant commissioner for trademarks since August 3, 1986.

Anderson has been employed in the U.S. Patent and Trademark Office since October 1979, first as an examining attorney and then as managing attorney in Law Office 4 of the Trademark Examining Operation. In 1984, he became the trademark administrator in the Office of the Assistant Commissioner for Trademarks. Prior to entering the Federal Government, Anderson worked as a research assistant at the University of Rochester and as an assistant professor at the State University of New York, teaching and doing research in the area of psycholinguistics and reading. He served in the United States Air Force between 1959 and 1968.

Anderson is a member of the Texas Bar and is admitted to practice before the U.S. Court of Appeals for the Federal Circuit. He received the Department of Commerce Silver Medal in 1986.

Feature

Trademark Operation Expands Telecommuting Pilot Program

by Debbie Cohn, Sr. Trademark Administrator, and Julie Quinn, Trademark Law Office 107

The United States Patent and Trademark Office is expanding its telecommuting program for attorneys to include at least 60 of its approximately 360 current trademark attorneys. A family-friendly workplace, the USPTO hopes to greatly expand the use of alternative work site options for an increasing percentage of its employees. The agency, in partnership with National Treasury Employees Union, has been operating a work at home pilot program for a small group of 18 trademark attorneys since 1997. Reports show that productivity and morale have increased as a result of the work at home arrangement.

As suburban sprawl and crowded highways become an everyday reality in the Washington metropolitan area, employers and employees are looking to telecommuting as a way of doing business for the future. Some of the primary goals of the USPTO program are to reduce time spent on the roads and to make additional space available in an agency which has seen its workload increase greatly over past years. In addition, providing a better quality of work life for employees will enable the organization to attract and retain highly qualified employees.

The USPTO's comprehensive guidelines have been used as a model for other federal agencies and private companies. The expanded program includes training for supervisors and participants and specific guidance on administrative, customer service, and performance issues. To determine the success of the two-year pilot program, the agency looked at the following areas: technology, employee performance and customer service, labor management relations, and employee satisfaction.

Technology: Implementing a work at home program in the USPTO has presented some unique challenges, primarily in the area of technology. Trademark examining attorneys work in a production environment using one-of-a-kind automated search and research tools contained in a number of live databases. The program involves the set up of a complete desktop work environment at participants' homes, enabling them to perform all of their job functions from a remote location. The pilot experience highlighted some areas where technology improvement was necessary, including the need to move away from costly ISDN connections. The new system architecture is based on internet connections, and is currently being installed for home testing.

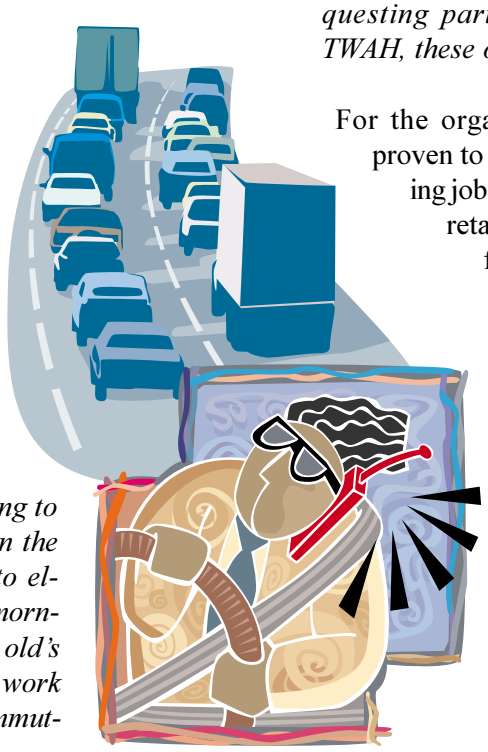
Performance and customer service: Compared with a control group of trademark examining attorneys in the office, pilot work at home employees were able to maintain or exceed performance goals. Productivity was positively affected. In addition, an independent customer telephone survey showed that work at home employees were able to provide the same high level of customer service as employees who remain in the office.

Labor Relations: All aspects of the program were developed and implemented in partnership with National Treasury Employees Union Chapter 245 and through

the USPTO Partnership Council. A labor/management partnership working group continues to provide oversight over the expanded program. The working group has been one of the most successful partnership efforts in USPTO history and serves as a model for future endeavors in partnership between USPTO management and union representatives.

Employee satisfaction: For the employee, there are many benefits to telecommuting. Most telecommuters report they get more done and are more satisfied with their jobs. The shortened commute decreases employee travel expenses and commuting stress, while enhancing the quality of work life and increasing the amount of time telecommuters have for family life and personal pursuits. Telecommuters also enjoy a greater degree of work-related autonomy and responsibility. Pilot participants made the following comments during evaluation sessions:

"The Flexiplace work at home program has saved me from two hours commuting time each day I worked at home. Instead of commuting to work I could put breakfast on the table, walk my 10 year old to elementary school, drive the morning carpool for my 13 year old's middle school and still start work earlier than I could when commuting to work."



"The single most significant benefit to me has been a wholesale improvement in morale. There is absolutely no comparison between the way I feel on my work-at-home days vs. in-office days. The work environment here at my rural Maryland home, with the view of mountains, trees and wildlife, possesses a general peace/quiet which is a far cry from the urban office environment and, in my opinion, a vast improvement. Participation in this program has probably extended my PTO career. [P]rior to the announcement of the TWAH pilot, [I] seriously considered leaving the PTO or requesting part-time status. Since starting TWAH, these options seem less appealing."

For the organization, telecommuting has proven to be an effective tool for improving job performance, helping recruit and retain valuable employees, and effectively using new technology to conserve limited physical resources such as office space. The agency has also been able to accommodate disabled employees or employees with emergency circumstances, while they continue productive work.

The first phase of the expanded program is scheduled to begin in spring 2000.

Centenarian Trademarks

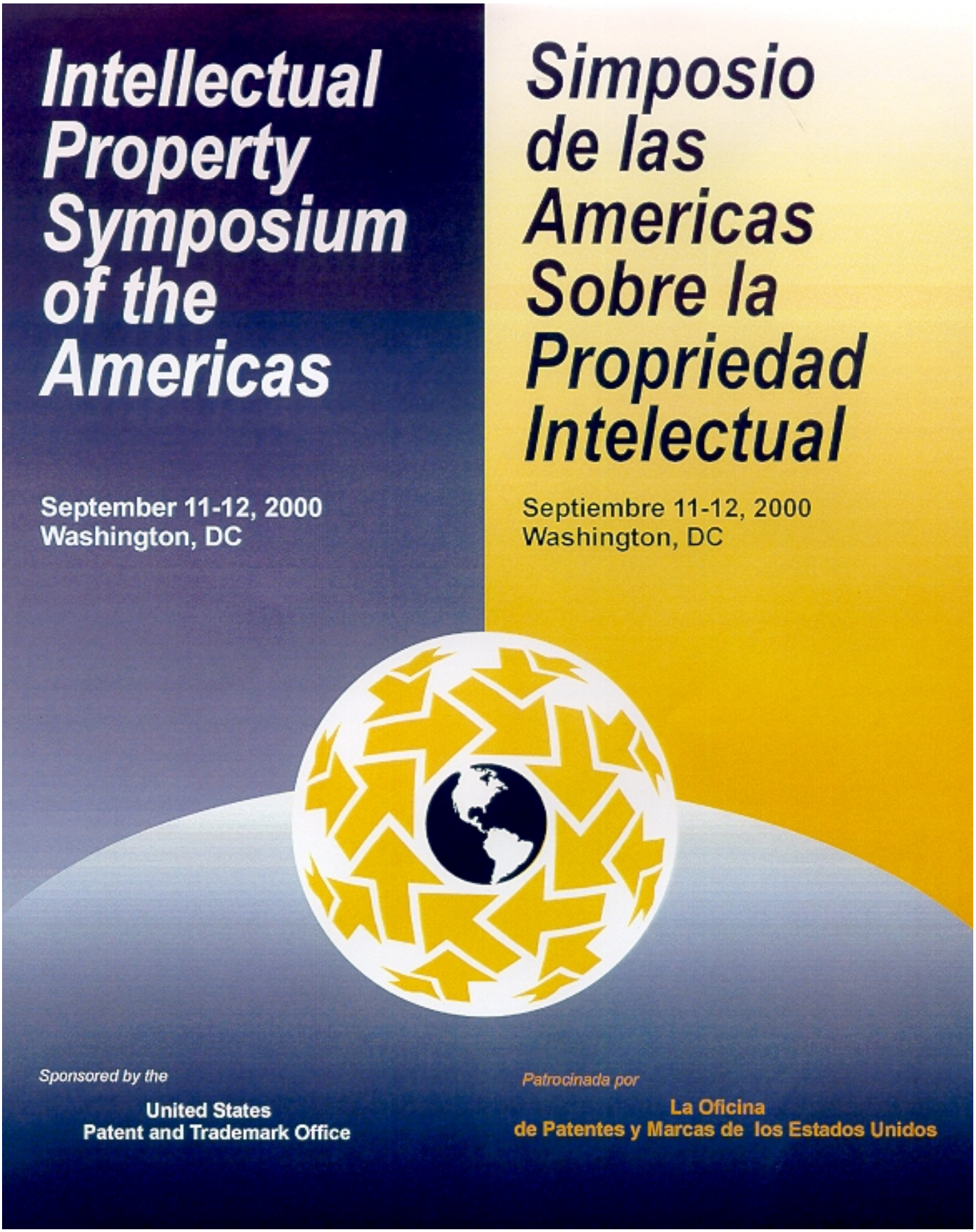
These trademarks were originally registered in 1900 and are still active today:

GE

Carnation Brand

Pabst Milwaukee Blue Ribbon Beer

Cream of Wheat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From the Editor

Since launching PTO TODAY online earlier this year, we have received many valuable comments from our readers. Your feedback is critical to future issues of the magazine, both online and in print. Only you can tell us how the publication satisfies your need for information as well as what areas of the magazine might be improved.

The following questionnaire will appear from time to time in USPTO TODAY. Please take a few moments to respond to the questions and return them either by e-mail to ruth.nyblod@uspto.gov or by mail to Editor, USPTO TODAY, U.S. Patent and Trademark Office, Office of Public Affairs, Washington, DC 20231.

1. What information, specifically, did you find most useful in this issue of USPTO TODAY?

2. What additional content/information would be helpful to include in future issues?

3. Did you find the information timely? *circle one*

   yes no not sure

4. How satisfied are you with a monthly online publication?

   very dissatisfied dissatisfied neither dissatisfied nor satisfied

   satisfied very satisfied

5. How often do you access USPTO TODAY online?

   1-2x/month almost never never

6. Would you like to be/remain on our mailing list for future copies of USPTO TODAY in print?

   yes no not sure

7. Please select the category which best describes your role with the USPTO.

   independent inventor corporate inventor small business owner
   attorney agent other_____

8. Is there someone else you know who should be receiving USPTO TODAY?
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